

REMARKS

The Office Action dated December 11, 2008, and the patents and publications cited therein have been carefully reviewed, and in view of the above changes and following remarks reconsideration and allowance of all the claims pending in the application are respectfully requested.

Claims 1-7, 9-18 and 20-22 stand rejected. By this Amendment, claims 1, 6, 7, 9, 12-18, and 20-22 have been amended. Claims 1-7, 9-18 and 20-22 remain pending.

The Amendments To The Claims

Applicants have amended claims 1, 9, 12 and 20 to improve their respective forms in accordance with U.S. patent law by addressing the rejection under 35 U.S.C. § 101 so that each of claims 1, 9, 12 and 20 is directed to statutory subject matter. In particular, each of claims 1, 9, 12 and 20 have been amended to comprise the concept of at least one data storage device and a plurality of servers accessing the at least one data storage device, each data storage device comprising at least one logical drive. Support for these amendments can be found throughout the originally filed patent application, for example, at least at paragraph [16], lines 6-7, 12 and 15. Applicants respectfully submit that these amendments to claims 1, 9, 12 and 20 are directed to formal matters, and are not in response to prior art. Therefore, no prosecution-history estoppel results from these amendments.

Claims 6, 7, 17 and 18 have been amended to improve their respective forms in accordance with U.S. patent law. Applicants respectfully submit that the amendments to claims 6, 7, 17 and 18 are directed to formal matters, and are not in response to prior art. Therefore, no prosecution-history estoppel results from these amendments to claims 6, 7, 17 and 18.

Applicants have amended claims 1, 9, 12 and 20 to comprise the concept of an on-demand storage area network. Support for these amendments to claims 1, 9, 12 and 20 can be found throughout the originally filed patent application, for example, at least at paragraph [16], lines 1-2, 9-10 and 13.

Applicants have amended claims 1 and 12 to comprise dynamically allocating a selected replica of the plurality of replicas of the master storage image to each server allocated to the system user based on traffic received by the on-demand storage area network. Applicants have also amended claims 9 and 20 to comprise allocating a separate writable data volume of the writable data portion of the selected master storage image to each server allocated to the system user based on traffic received by the on-demand storage area network. Support for these amendments to claims 1, 9, 12, and 20 can be found throughout the originally filed patent application, for example, at least in paragraph [14].

The Rejection Under 35 U.S.C. § 101

Claims 1-7 and 9-11 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Additionally, claims 12-18 and 20-22 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Applicants have amended claims 1 and 9 to comprise the concept of at least one data storage device and a plurality of servers accessing the at least one data storage device, each data storage device comprising at least one logical drive. Thus, claims 1-7 and 9-11 now include hardware and are, therefore, directed to statutory subject matter.

Applicants have amended claims 12 and 20 to comprise the concept of at least one data storage device and a plurality of servers accessing the at least one data storage device, each data storage device comprising at least one logical drive. Thus, claims 12-18 and 20-22 now include computer hardware and are, therefore, directed to statutory subject matter.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection.

The Rejection Under 35 U.S.C. § 103(b) Over Watt In View Of Scheer

Claims 1, 6, 12 and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Watt, U.S. Patent Application Publication No. 2003/0126202 A1, further in view of Scheer et al. (Scheer), U.S. Patent Application Publication No.2003/0131078 A1.

Applicants respectfully traverse this rejection. Applicants respectfully submit that the subject matter according to any of claims 1, 6, 12 and 17 is patentable over Watt in view of Scheer. In particular, Applicants respectfully submit that the Examiner has not presented a convincing line of reasoning as to why an artisan would have found the subject matter of claims 1, 6, 12 and 17 to have been obvious in light of the teachings of Watt and Scheer. Further, even if Watt and Scheer are combined, the resulting method and device is not the subject matter of any of claims 1, 6, 12 and 17.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (See, also, MPEP §§ 706.02(j) and 2144.)

In the present rejection, the Examiner does not state that either Watt or Scheer expressly or impliedly suggest the subject matter of claims 1, 6, 12 and 17. Consequently, in order to support the present rejection, the Examiner’s line of reasoning must be convincing as to why the artisan would have found the claimed subject matter to have been obvious in light of the teachings of Watt and Scheer.

Regarding claims 1 and 12, Applicants respectfully submit that regardless how well the conclusion of the Examiner’s syllogism appears to follow from the stated major and minor premises, one of ordinary skill in the art would, at best, conclude that the functionality of Watt (set forth in the major premise) and the functionality of Scheer (referred to in the minor premise) would permit Watt and Scheer to be combinable. But, contrary to the Examiner’s conclusion, one of ordinary skill in the art would conclude that the resulting method and system would provide a functionality that is no different from the functionality already provided by Watt. That is, the functionality of Scheer referred to in the minor premise of the syllogism is already provided by Watt, thereby making Scheer, at best, cumulative to Watt. For that matter, Applicants respectfully submit that even if one of ordinary skill in the art even bothers to

combine the functionality of Watt with the functionality of Scheer, as proffered by the Examiner, the resulting method and device only differs from the original Watt invention by now having the word “pre-configured” available for use in the description of the functionality of Watt.

As the Examiner points out in the major premise, lines 6-10 of paragraph [0046] of Watt discloses that the Watt invention provides the capability of allowing an administrator to pick and choose from an installed software base to create a master server image, so that once defined, the server image can be rapidly replicated and configured using automated tools to build out images for an entire server pool. (See Office Action dated December 11, 2008, page 6, lines 14-17.) Moreover, Watt also discloses that full life-cycle management is provided with easy patching, upgrades, and rollbacks. (See Watt, paragraph [0046], lines 11-12.)

Applicants respectfully submit that this functionality of Watt is identically provided by Scheer. In the Examiner’s minor premise at page 6, lines 17-18, of the Office Action dated December 11, 2008, the Examiner states “Scheer more explicitly discloses pre-configuration of the image.” Examiner then uses these two identical functionalities to conclude that Watt and Scheer are capable of being combined. Applicants do not take issue with the conclusion of the Examiner syllogism to the extent that Watt and Scheer could be combined. Applicants take issue with the aspect of the Examiner’s conclusion that places extraordinary significance on Scheer’s use of the word “pre-configured.” It is that extraordinary significance that the Examiner uses to force the method and device resulting from inclusion of Scheer into Watt to become the claimed subject matter.

Looking closer at the functionality of Scheer, Scheer is directed to a technique for configuring a digital image for one or more target servers, building the digital image, and deploying the digital image onto the one or more target servers. (See Scheer, paragraph [0001], lines 1-3, and paragraph [0004], lines 1-3.) As disclosed in the Background of the Invention portion of Scheer, servers generally have pre-installed software to perform a dedicated service. (See Scheer, paragraph [0002], lines 3-4.) As such, Scheer discloses that a server is usually required an end user to ship the hardware back to the manufacturer in order to fundamentally change the purpose of a server. (See Scheer, paragraph [0002], lines 9-11.) Scheer also

describes problems with integration of a server farm as requiring manual coordination of the protocols for network monitoring, building images, deployment and components. (See Scheer, paragraph [0003].)

To overcome these problems, Scheer provides a master configurator 102 that is an improvement over configuring and deploying servers as it was known prior to the Scheer invention. As disclosed by Scheer, master configurator 102 builds the digital images for one or more components in a network in order to create a designed network. Scheer refers to the building operations performed by master configurator 102 as “dynamically” building the digital images because the building operations that incorporate the operational network configuration settings are performed “on the fly” as opposed to building a digital image beforehand during the manufacturing process. (See Scheer, paragraph [0012], lines 15-20.) Accordingly, the “on the fly” characterization by Scheer of the building operations performed by master configurator 102 is in contrast to (1) a digital image being made beforehand during the manufacturing process, and (2) shipping the hardware back to a manufacturer in order to fundamentally change the purpose of the hardware.¹

To illustrate the dynamic aspect of the “on the fly” capabilities of master configurator 102, paragraphs [0017]-[0020] of Scheer disclose an embodiment in which master configurator 102 assists in the design, address configuration, links configuration, a deployment of a digital image on individual servers in a server farm. According to Scheer, a first network design 112 may cause master configurator 102 to build, configure and deploy a network having a firewall server, a web server and an email server all routed by a router 104 to the same domain name. Master configurator 102 imports from a database a generic digital image containing all of the necessary software to create a functional firewall server. Master configurator 102 then consults a design rule logic block 220 (Figure 2 of Scheer) to determine that the firewall server should be layered in the first network design as the first device to receive incoming data packets so that anti-virus and security software provided by the firewall server can protect the inner network components of

¹ Recall that Scheer discloses that it was required for an end user to ship the server hardware back to a manufacturer in order to fundamentally change the purpose of the hardware. (See Scheer, paragraph [0002], lines 9-11.)

the first network design. Master configurer 102 also configures links into the digital image for the firewall server between the firewall server and the router, and between the firewall server and the web server, as well as the e-mail server. Master configurer 102 further configures network settings in the digital images for the e-mail server and the web server to work cohesively with the firewall server and each other. Master configurer 102 then configures the IP addresses and links for the digital images of the web server and the e-mail server.

At this point in the Scheer disclosure (Scheer, paragraph [0019], lines 6-9), Scheer summarizes how master configurer 102 assists in the design, address configuration, links configuration of a digital image on an individual server in a server farm by stating that “[t]he master configurer 102 dynamically builds digital images for each network component once the generic digital images are imported and pre-configured to be fully operational.” Scheer continues in paragraph [0020] and discloses that the “pre-configured” digital images are deployed dynamically over a network connection in response to a net boot request from a server.

Applicants respectfully submit that Watt already provides the functionality of the Scheer master configurer 102 for dynamically building digital images for each network component once the generic digital images are imported and configured to be fully operational. In particular, paragraph [0046], lines 6-12, of Watt discloses how repository manager 210 allows an administrator to pick and choose from the installed software base (i.e., the generic digital image of Scheer) to create a master server image 217. Once defined, the Watt master server image can be rapidly replicated and configured using automated tools to build out images for an entire server pool. (See Scheer, paragraphs [0018]-[0020], and recall the Examiner’s major premise.) Full life-cycle management is provided with easy patching, upgrades, and rollbacks. (See Scheer, paragraph [0021].)

Because the disclosure of Scheer is, at best, cumulative to the disclosure of Watt, Applicants respectfully submit that one of ordinary skill in the art would really have no reason to include the Scheer functionality in the Watt system because Watt already provides all of the Scheer functionality, other than one of ordinary skill in the art could make such an inclusion. Nevertheless, the Examiner makes the combination by zeroing in on Scheer’s use of the word

“pre-configured.” Applicants respectfully submit that because the Examiner focuses on the word “pre-configured,” the Examiner is able conveniently ignore the actual context of Scheer’s use of the word “pre-configured” in order to imply that the ‘more explicit’ disclosure of Scheer is the same subject matter as the claimed preconfiguring. It should be noted that the context in which Scheer discloses the “pre-configured” generic digital images has nothing to do with dynamically allocating storage to a system user of an on-demand storage network. Accordingly, Applicants respectfully submit that when the true context in which Scheer uses the word “pre-configuration” is not ignored, it becomes plain that the only reason that Scheer has been relied on for this rejection is because Scheer uses the word “pre-configured” in connection with a generic digital image that has been imported into and dynamically built by master configurer 102. While a person of ordinary skill is attributed to be a person of ordinary creativity (see *KSR Int’l Co. v. Teleflex Inc.*, 127 St. Ct. 1727, 1742 (2007)), Applicants respectfully submit that in view of the actual disclosure of Scheer, one of ordinary skill in the art would need to have extraordinary creativity to modify Watt in the manner proffered by the Examiner.

Applicants respectfully submit that the Examiner’s syllogism suggests that Watt and Scheer could be combined, but with the resulting method and device providing no new functionality than that already provided by Watt. (In fact, Applicants respectfully submit that functionality of Scheer could be combined into Watt as proffered by the Examiner without any discernable difference to Watt, except for the word “pre-configured” now being available for use in the description of the Watt functionality.) Moreover, Applicants respectfully expect that the Examiner will seize the fact that Applicants not taking issue with the conclusion of the syllogism to the extent that the syllogism concludes that Watt and Scheer could be combined, and ignore the issues raised by Applicants with the Examiner’s conclusion. Accordingly, Applicants respectfully request that the Examiner please explain how one of ordinary skill in the art (having ordinary creativity) would conclude that the word “pre-configured,” as used in the context disclosed by Scheer, would be motivated to modify Watt to provide dynamically allocating a selected replica of the plurality of replicas of the master storage image to each server allocated to the system user based on traffic received by the on-demand storage area network. Thus, even if

Watt and Scheer are combined, the resulting method and device is not the subject matter of any of claims 1, 6, 12 and 17.

The bottom line is that Applicants respectfully submit that there may be unidentified prior art that causes the claimed subject matter of claims 1, 6, 12 and 17 to be unpatentable, but in this case, the Examiner has not made a *prima facie* case of obviousness of the claimed subject matter, unless such a showing of obviousness is predicated on merely finding use of a word and not on the context in which the word is used.

Accordingly, Applicants respectfully submit that it is only by impermissible hindsight that the Examiner is able to reject claims 1, 6, 12 and 17 based on the combination of Watt and Scheer. The Examiner does not state that either of Watt or Scheer expressly or impliedly suggests the claimed subject matter. Moreover, the Examiner has not presented a convincing line of reasoning as to why the artisan would have found the claimed subject matter to have been obvious in light of the teachings of Watt and Scheer. Further still, even if Watt and Scheer are combined, the resulting method and device is not the claimed subject matter. Thus, it is only by using Applicants' disclosure as a template that the Examiner is able to select particular features of Watt and the use of the word "pre-configured" by Scheer through a hindsight reconstruction of Applicants' claims to make the rejection.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 1, 6, 12 and 17.

The Rejection Under 35 U.S.C. § 103(a) Over Watt In View of Scheer And Sheets

Claims 2-5, 7, 13-16 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Watt in view of Scheer and Sheets et al. (Sheets), U.S. Patent No. 6,8106,905.

Applicants respectfully traverse this rejection. Applicants respectfully submit that Sheets does not cure the deficiencies of Watt and Scheer with respect to claims 1 and 12, the respective base claims of claims 2-5 and 7, and claims 13-16 and 18. That is, Sheets does not cure the unconvincing line of reasoning used by the Examiner for combining Watt and Scheer to reject claims 1 and 12.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 2-5, 7, 13-16 and 18.

The Rejection Under 35 U.S.C. § 103(a) Over Watt In View of Edelstein

Claims 9 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Watt in view of Edelstein et al. (Edelstein), U.S. Patent Application Publication No. 2004/0172395 A1.

Applicants respectfully traverse this rejection. Applicants respectfully submit that the subject matter according to either of claims 9 and 20 is patentable over Watt in view of Edelstein. In particular, even if Watt and Edelstein are properly combined, the resulting method and device is not the subject matter of any of claims 9 and 20.

The Examiner admits at page 17, lines 9-11, and page 20, lines 14-16, of the Office Action dated December 11, 2008, that

“Watts [sic] does not explicitly disclose, ‘allocating a separate writable data volume of the writable data portion of the selected master storage image to each server allocated to the system user’ and ‘writeable data portion’[.] [sic]”

Moreover, because Watt does not admittedly explicitly disclose allocating a separate writable data volume of the writable data portion of the selected master storage image to each server allocated to the system user, Watt simply cannot disclose or suggest allocating a separate writable data volume of the writable data portion of the selected master storage image to each server allocated to the system user based on traffic received by the on-demand storage area network.

At page 17, lines 12-15, and page 20, lines 17-20, the Examiner characterizes Edelstein in terms of the language of claims 9 and 20, by stating

“On the other hand, Edelstein discloses ‘allocating a separate writable data volume (written to the server as file 210) of the writeable data portion of the selected master storage image (file is locked so that user A has read/write privileges) to each server (server) allocated to the system user (user)’ and ‘writeable data portion’ (written to the server)[.] [sic]”

Applicants respectfully submit that the Examiner's characterization of Edelstein in terms of the language of claims 9 and 20 is a "free association" that contorts Edelstein file 210 into a separate writeable data volume of the writeable data portion of a master storage image without any regard for the on-demand storage server network environment of claims 9 and 20.

It should be noted that Edelstein discloses a technique that addresses the problem associated with a dual-use file that is stored on a server computer, in which some users that can access the file can open the file as a read-only file, while other users can modify the file. (See Edelstein, paragraphs [0002]-[0005].) Edelstein discloses a modified file open technique in a file can be initially opened without the file being locked, but then can become locked when a user indicates that the user is attempting or intending to edit the file. (See Edelstein, paragraph [0006].) Edelstein discloses or suggests nothing about an on-demand storage server network environment.

Applicants respectfully submit that the Examiner's "free association" works only if the on-demand storage server network environment of the subject claims is ignored. Applicants respectfully submit that while a person of ordinary skill is also a person of ordinary creativity (see *KSR Int'l Co. v. Teleflex Inc.*, 127 St. Ct. 1727, 1742 (2007)), Applicants respectfully submit that one of ordinary skill in the art would need to have nothing less than extraordinary creativity to morph Edelstein file 210 into a separate writeable data volume of the writeable data portion of a master storage image in the on-demand storage server network environment of claims 9 and 20.

Further, Applicants respectfully submit that even if it is proper to ignore that Edelstein file 210 has nothing to do with a separate writeable data volume of the writeable data portion of a master storage image in an on-demand storage server network environment of claims 9 and 20, it certainly cannot be proper to freely associate the concept of the Edelstein file 210 into a separate writeable data volume of the writeable data portion of a master storage image allocating a separate writeable data volume of the writeable data portion of the selected master storage image to each server allocated to the system user based on traffic received by the on-demand storage area network. Moreover, such creativity can only be way beyond the ordinary creativity attributed to one of ordinary skill in the art.

The bottom line for this rejection is that Applicants respectfully submit that there may be unidentified prior art that causes the claimed subject matter of claims 9 and 20 to be unpatentable, but for this rejection, the Examiner has not made a *prima facie* case of obviousness, unless it is proper to ignore that Edelstein does not disclose or suggest the claimed separate writeable data volume of the writeable data portion of a master storage image allocating a separate writable data volume of the writable data portion of the selected master storage image to each server allocated to the system user based on traffic received by the on-demand storage area network.

Accordingly, Applicants respectfully submit that it is only by impermissible hindsight that the Examiner is able to reject claims 9 and 20 based on the combination of Watt and Edelstein. The Examiner does not state that either of Watt or Edelstein expressly or impliedly suggests the claimed subject matter. Thus, it is only by using Applicants' disclosure as a template that the Examiner is able to select particular features of Watt and morph the concepts of the Edelstein file 210 through a hindsight reconstruction of Applicants' claims to make the rejection.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 9 and 20.

**The Rejection Under 35 U.S.C. § 103(a) Over Watt
Further In View of Edelstein And Sheets**

Claims 10, 11, and 20-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Watt further in view of Edelstein and Sheets.

Applicants respectfully note that "[c]laims 10-11 and 20-22" are identified as the claims rejected as unpatentable over Watt further in view of Edelstein and Sheets. (See Office Action dated December 11, 2008, page 21, lines 10-13.) Applicants respectfully note that the Examiner has not set forth any discussion regarding claim 20 for this rejection. Consequently, in the following remarks, Applicants will not address a rejection of claim 20.

Applicants respectfully traverse this rejection. Applicants respectfully submit that Sheets does not cure the deficiencies of Watt and Edelstein with respect to claims 9 and 20, the respective base claims of claims 10 and 11, and claims 21 and 22. In particular, Sheets does not cure the lack in claims 9 and 20 of the claimed separate writeable data volume of the writeable data portion of a master storage image allocating a separate writable data volume of the writable data portion of the selected master storage image to each server allocated to the system user based on traffic received by the on-demand storage area network.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 10, 11, 21 and 22.

Applicants note that additional patentable distinctions between Watt, Scheer, Sheets and Edelstein the rejected claims exist; however, the foregoing is believed sufficient to address the Examiner's rejections. Additionally, failure of Applicants to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Applicants do not agree.

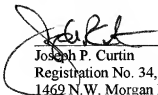
CONCLUSION

In view of the above amendments and arguments, it is urged that the present application is now in condition for allowance. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below.

It is requested that this application be passed to issue with claims 1-7, 9-18 and 20-22.

Respectfully submitted,

Date: February 12, 2009



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